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10/797,831	03/10/2004	Wonkoo Kim	24272/81201	5657
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SIDLEY AUSTIN LLP 555 CALIFORNIA STREET SUITE 2000 SAN FRANCISCO, CA 94104-1715			UTAMA, ROBERT J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b><i>Office Action Summary</i></b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/797,831	KIM, WONKOO
<b>Examiner</b>	<b>Art Unit</b>	
	Robert J. Utama	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 10 March 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-29 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 10 March 2004 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_.  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 03/10/2004. 5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-20, and 27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recite the limitation of a system comprised of multiple devices with the first device of being a DVD drive; the applicants then claimed that the first device is operable to display word upon a display. However, the first device (a DVD drive) does not contain any elements that can be considered to have the ability to display words or any other visual elements. Hence, it is not clear if the first device have the ability to function as claim 1 requires. Additionally, the first device (a DVD drive) as claimed in claim 1 is able to reproduce a user's spoken rendition. However, the first device (a DVD drive) does not contain any elements that can be considered to have the ability to reproduce a user's spoken rendition (i.e. audio transducer and etc). Hence, it is not clear from the claim language as it currently stand how the first device is able to function as claimed. Claims 2-14 are also rejected due to its dependencies to a rejected claim. Claim 15 recites the limitation of a first device however, no other first device appear on this independent claim. Hence, the examiner is unclear the function and other features of this first device. Claim 16 –20 are also rejected due to its dependencies to a rejected claim. Claim 17 recites the limitation of the reproduction of the spoken rendition is to be done in real time. However, the specification and claim language as it currently stand does not specify anything that one of ordinary skilled in the art can use to judge whether or not a device as reproducing a rendition in real time. Hence, for the course of the examination the phrase reproducing in real time is taken to mean to reproduce spoken rendition in a normal rate of speech. Claim 27 recites a limitation that the remote control to be child size. However, the specification and the claim language as it currently stand does not

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specify or teach what dimension can be considered child size by one of ordinary skilled in the art. Hence, for the purpose of this office action the term child size is interpreted to mean can be operated by a child.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 26 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a microphone that is operable to receive the operators spoken version of the word, does not reasonably provide enablement for transmitting a signal representing said spoken word. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. A microphone is currently known in the art as a passive transducer, that responds to air pressure level changes in the environment. A further reading of the applicant's specification it is clear that another device (an IR transducer) is the one that is responsible to transmit audio signal received by the microphone to the language learning system (see page 6 paragraph 29).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claim 29 rejected under 35 U.S.C. 102(b) as being anticipated by Derks et al 6,012,119.**

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**Claim 29:** Derks '119 provide a teaching for a remote control with a top side of having a microphone and keys that control a distant device (see FIG. 2 item 46 and 36), while not shown in the specs it would have been inherent that the device shown having an underside which includes a grouping of transducer that transmit control signal and sound received by the microphone to the distant device (see col. 6:20-36). It would have been inherent that the teaching of transducers of Derks '119 is situated such that the remote can be held substantially upright or horizontal (or other position) and able to transmit control and sound signals directly to the distant device in either position. Derks' teaching of using an RF-based data/signal transmitter [see col. 6:21-37] (antennae) and receiver are not limited to the line-of-sight nor it is affected by physical orientation of the device. Should one were to held the device in any orientation (i.e.: horizontal or upright) Derks' device would still be able to transmit and receive the RF control and audio signals.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**8. Claim 1-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Wakamoto 2001/0008753, in view of Derks et al 6,021,119.**

**Claim 1:** Wakamoto provide a teaching of device a learning system comprising of: a DVD drive (see Wakamoto 753 paragraph 97), a first device operable to display words in a first language upon a display (subtitles) and playback a pre-recorded rendition of the one or more words (see Wakamoto 753 paragraph 98), and the first device that is operable to reproduce said spoken rendition (see Wakamoto 753 paragraph 100 and 55).

Wakamoto 753 fails to provide teaching of a remote control comprising of controls and a microphone and such remote control is operable to receive a users spoken rendition and transmit it to the first device. However, Derks provide a teaching of a remote control comprising control and microphone, such that the remote is operable to receive user spoken rendition of the one or more displayed word and transmit said spoken rendition to the base device (Derks FIG. 2 and col. 6:20-36). Therefore, it would have been obvious for person of ordinary skilled in the art to include the feature of a remote control comprising control and microphone, such that the remote is operable to receive user spoken rendition of the one or more displayed word and transmit said spoken rendition to the base device, as taught by Derks '119, into the system of Wakamoto because it would reduce the need of having separate component for the remote and microphone into one system.

**Claim 2:** Wakamoto '753 provided a teaching of system where it is operable to reproduce said spoken rendition simultaneously with the pre-recorded rendition (see paragraph 100 and 101).

**Claim 3:** Wakamoto '753 a teaching of system where it is operable to reproduce said spoken rendition sequentially with the pre-recorded rendition (see paragraph 74).

**Claim 4:** Wakamoto '753 provided the system is operable to receive and record speech from the user (see paragraph 100 and 55).

**Claim 5:** Wakamoto '753 provided the system is operable such that the user can repeat her spoken and recorded rendition multiple times until satisfied with her rendition (see paragraph 55).

**Claim 6:** Wakamoto '753 provided a teaching where the user can select additional words to practice with the remote control (paragraph 66).

**Claim 7:** Wakamoto '753 provided a teaching where the first display can display the words in the first language and additional language simultaneously (see Wakamoto Table 2).

**Claim 8:** Wakamoto '753 provided a teaching wherein the additional language is a user preferred language (see Wakamoto paragraph 105).

**Claim 9 and 24:** Wakamoto fails to provide a teaching where the microphone is activated by the one of the control of the remote control. However, Derks provide a teaching where the microphone on the remote is activated by one of the control on the remote (see Derks col. 2:17-26). Therefore, it would have been obvious for person of ordinary skilled in the art to include the feature of microphone is activated by the one of the control of the remote control, as taught by Derks '119, into the system of Wakamoto because it would reduce the need of having separate component for the remote and microphone into one system.

**Claim 15:** Wakamoto provide a teaching of teaching and learning of a foreign language that is comprised of: a first device operable to display words in a foreign language upon an electronic display (subtitles), reproducing such word over a speaker (see Wakamoto 753 paragraph 98) and reproducing spoken version of the word through the speaker (see Wakamoto 100) Wakamoto fails to provide teaching for receiving at the remote control, a student's spoken version of the at least one displayed word, and transmitting from said remote control the version to the base device. However, Derks provide a teaching of a remote control comprising control and microphone, such that the remote is operable to receive user spoken rendition of the one or more displayed word and transmit said spoken rendition to the base device (Derks FIG. 2 and col. 6:20-36). Therefore, it would have been obvious for person of ordinary skilled

in the art to include the feature of a remote control comprising control and microphone, such that the remote is operable to receive user spoken rendition of the one or more displayed word and transmit said spoken rendition to the base device, as taught by Derks '119, into the system of Wakamoto because it would reduce the need of having separate component for the remote and microphone into one system.

**Claim 16:** Wakamoto provide a teaching of recording a spoken version for playback when requested (see paragraph 100 and 55).

**Claim 17:** It is inherent from the teaching of Wakamoto that the reproduction of the spoken material is done in real time, as explained in the 112 2<sup>nd</sup> rejection, real time in this case is interpreted to mean at the normal speech rate.

**Claim 18:** Wakamoto provide a teaching where portions of the foreign language is stored on a DVD (see paragraph 97-98).

**Claim 19:** Wakamoto provide a teaching where the production of a spoken reference of at least one word when displaying said at least one word (see paragraph 98).

**Claim 20:** Wakamoto provide a teaching where the spoken version is that of a native speaker of the foreign language (see paragraph 107).

**Claim 21:** Wakamoto provide a teaching of providing a foreign language education content on an optical disc at a first device (see paragraph 97 and 91), causing a words in the foreign language to appear on the display, providing a reference-spoken version of the displayed word (see Wakamoto paragraph 98) and playing back the user's spoken version at the device (see Wakamoto 753 paragraph 100 and 55).

Wakamoto fails to provide a teaching of receiving at a microphone in a remote control, the student spoken version of the displayed word while the word appears on the display, modulating said spoken version into a signal at the remote control, transmitting the modulated signal to the device and demodulating the signal at the device. However, Derks provide a teaching of a remote control comprising control and microphone, such that the remote is

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operable to receive user spoken rendition of the one or more displayed word and transmit said spoken rendition to the base device (Derks FIG. 2 and col. 6:20-36). It would have been inherent from Dreks teaching that the voice signal is modulated at the remote control (see Dreks FIG. 4 item 47a and col. 6:15-35) and demodulated at the base device for voice reproduction (see FIG. 5 item 140 and 142 and col. 6:39-45). Therefore, it would have been obvious for person of ordinary skilled in the art to include the feature of a remote control comprising control and microphone, such that the remote is operable to receive user spoken rendition of the one or more displayed word and transmit said spoken rendition to the base device, as taught by Derks '119, into the system of Wakamoto because it would reduce the need of having separate component for the remote and microphone into one system.

**9. Claim 10 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Wakamoto 2001/0008753, in view of Derks et al 6,021,119 and further in view of Fang 6,663,847.**

**Claim 10 and 25:** Wakamoto fails to provide a teaching of a voice-activated microphone. The combination of Wakamoto and Derks also fails to rectify this deficiency. However, Fang '847 provides a teaching of a voice-activated microphone (see Fang col. 2:25-35). Therefore, it would have been obvious for one of ordinary skilled in the art to include the feature of voice-activated microphone, as taught by Fang, into the system of Wakamoto and Derks because it would enable hands free operation of the microphone on the device (see Fang col. 1:13-16).

**10. Claim 11-12, 22-23 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Wakamoto 2001/0008753, in view of Derks et al 6,021,119 and further in view of Weemote.**

**Claim 11 and 22:** Wakamoto fails to provide a teaching of remote having a remote control that is child sized, having a pear like shapes with a distal lobe and a proximal lobe that is sized to

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fit in the palm of the a child's hand. The combination of Wakamoto and Derks also fails to rectify this deficiency.

Weemote provided a teaching of a remote a teaching of remote having a remote control that is child sized, having a pear like shapes with a distal lobe and a proximal lobe that is sized to fit in the palm of the child's hand (see Weemote page 2 center figure). Therefore, it would have been obvious to include the feature of having a remote that is child sized, having a pear like shapes with a distal lobe and a proximal lobe that is sized to fit in the palm of the child's hand, as taught by Weemote, into the combination of Wakamoto and Derks because it such shape is more suitable and attractive to young children (see Weemote page 3 paragraph 1).

**Claim 12 and 23 and 28:** The combination of Wakamoto, Derks and Weemote fails to provide a teaching that the proximal lobe is about 60 millimeters long and the remote is about 120 mm long and where the width of the remote control have a maximum width of 60 millimeters (Claim 28).

At the time the invention was made, it would have been an obvious matter of design choice to an ordinary person skilled in the art to construct the remote with the dimension of the proximal lobe that is about 60 millimeters long, having the maximum width of 60 mm and having a remote that is 120 mm long; because the applicant has not disclosed that dimension of proximal lobe that is about 60 millimeters long and a remote that is about 120 mm long provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skilled in the art would have expected that the applicant's invention and the dimension of the Weemote to perform equally well in enabling a user of young age to use the remote.

Therefore, it would have been *prima facie* obvious to modify of Wakamoto, Derks and Weemote to obtain the invention as specified in claim 12, 23 and 28 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Wakamoto, Derks and Weemote.

**Claim 26:** Wakamoto provide a teaching of remote control (see Wakamoto paragraph 52 and 57) that is operable to cause the system to display a group of words to be learned by an operator of the remote and the system (Wakamoto paragraph 66), operable to cause the language learning system to sonically reproduce a reference pronunciation of the displayed word (see Wakamoto 753 paragraph 98). Wakamoto system is operable to amplify and reproduce signals of the user's spoken version (see Wakamoto FIG. 6) and pre-recorded version in order to allow the operator to compare his spoken version to the reference version (see Wakamoto paragraph 55, 74 and 102)

Wakamoto fails to provide a teaching of remote having microphone with infrared transducers and having such remote with a microphone that is operable to receive the operator's spoken version of the displayed words. However, Derks provide teaching remote having microphone and having such remote with a microphone that is operable to receive the operator's spoken version of the displayed words (Derks FIG. 2 and col. 6:20-36). Therefore, it would have been obvious for person of ordinary skilled in the art to include the feature of a remote control comprising control and microphone, such that the remote is operable to receive user spoken rendition of the one or more displayed word and transmit said spoken rendition to the base device, as taught by Derks '119, into the system of Wakamoto because it would reduce the need of having separate component for the remote and microphone into one system.

Derks does not provide a teaching of infrared transducer as mean of signal transmission; instead Dreks provides a teaching of using radio signals as means of signal transmission. However, signal transmission via IR transducer (as proposed by the applicant) or EMF based transmitter (such as proposed by Dreks) is recognized to perform the same function. One of ordinary skilled in the art would have expected that the applicant's invention and the mean of signal transmission as taught by Dreks to perform equally well as a mean of communication. Therefore, it would have been *prima facie* obvious to modify of Wakamoto and Derks to obtain the invention as specified in claim 26 because such a modification would

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have been considered a mere design consideration which fails to patentably distinguish over the prior art of Wakamoto and Derks.

Wakamoto fails to provide a teaching of remote having a remote control that is child sized, having a pear like shapes with a distal lobe and a proximal lobe that is sized to fit in the palm of the a child's hand. The combination of Wakamoto and Derks also fails to rectify this deficiency.

Weemote provided a teaching of a remote a teaching of remote having a remote control that is child sized, having a pear like shapes with a distal lobe and a proximal lobe that is sized to fit in the palm of the child's hand (see Weemote page 2 center figure). Therefore, it would have been obvious to include the feature of having a remote that is child sized, having a pear like shapes with a distal lobe and a proximal lobe that is sized to fit in the palm of the child's hand, as taught by Weemote, into the combination of Wakamoto and Derks because it such shape is more suitable and attractive to young children (see Weemote page 3 paragraph 1).

**11. Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Wakamoto 2001/0008753, in view of Derks et al 6,021,119 and further in view of Gleisnner 2004/0152054.**

**Claim 14:** Wakamoto fails to provide a teaching of having a button that causes with one touch, the dictionary meaning of one or more displayed words to appear in the display. The combination of Wakamoto and Derks also fails to rectify this deficiency.

Gleisnner provided a teaching of a button that causes with one touch, the dictionary meaning of one or more displayed words to appear in the display (see FIG. 2A item 203 and paragraph 27). Therefore, it would have been obvious to one ordinary skilled in the art to include the feature of button that causes with one touch, the dictionary meaning of one or more displayed words to appear in the display, as taught by Gleisnner, because it would permit the user to learn more about the meaning of such word (see Gleisnner paragraph 53).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Utama whose telephone number is (571) 272-1676. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezutto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**KATHLEEN MOSSER**  
**PRIMARY EXAMINER**  
**ART UNIT 3714**